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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,353	12/12/2003	Lawrence W. Hu	GUID-011CON2	3571

36154 7590 05/09/2008

LAW OFFICE OF ALAN W. CANNON
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EXAMINER	
MAI, HAO D	

ART UNIT	PAPER NUMBER
3732	

MAIL DATE	DELIVERY MODE
05/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/734,353	HU ET AL.	
	Examiner	Art Unit	
	HAO D. MAI	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-10,12,13,15,16 and 84-108* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-10,12,13,15,16 and 84-101* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-2, 5-10, 12-13, 15-16, and 101-108 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-10, 12-13, and 15-16, of U.S. Patent No. 6,685,632 B1.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language/limitation "at least one actuator" (claim 1) of Patent '632 is considered to be equivalent to the newly amended claim language/limitation "a single actuator" (claims 1 and 101) of the present Application.

3. **Claims 84-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock (6,331,157 B2).**

The Patent '632 claims do not include a retractor with a drive mechanism driving the retractor blades. Hancock shows a retractor system comprising a drive mechanism 22 and first and second retractor blades 24, 26 being drivable or spreaded apart by the drive mechanism 22 (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide the Patent claims with the retractor shown by Hancock as an alternate stable support for the instrument mount and stabilizer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Looney (5,876,332).**

Looney discloses an instrument mount (Fig. 2) apparatus comprising: a mount body 164 having a base portion moveably coupled at a first articulating joint 20/105 and a side portion coupled at a second articulating joint 102/103, and a single actuator 108 (Fig. 2). The single actuator 108 is disclosed to be operatively connected to the first and second articulating joints; both joints being freely moveable when the actuator 108 is in an unlocked position, wherein the two articulating joints are compressed each into a substantially immovable condition (Fig. 2; column 8 lines 14-24). The first articulating joint 20/105 is at an angle of less than about 120 degrees to the second articulating joint 102/103 (Fig. 2). As to claim 5, the single actuator 108 is disclosed to comprise a base post.

6. **Claims 101-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Cartier (6,102,854).**

Cartier et al. disclose an instrument mount apparatus (Figs. 3 and 5B) comprising: a grip member 50 capable of being locked to and released from a stable support/rail 40 via flange 521; at least one joint member of ball 54/56 and socket 524 capable of movably connecting a surgical instrument 60 to the grip member 50; a locking mechanism of a single actuator 51 which can both lock the grip member 50 to the stable support/rail 40 and lock an orientation of the surgical instrument 60 (Figs. 3, 5B; column 10 lines 60-67).

The stable support or rail 40 is disclosed to be a retractor (Fig. 2). The grip member 50 is attached to and slidable with respect to the stable support/rail 40. The joint member of ball 54/56 and socket 524 is a rotational ball joint. The surgical instrument of rod 60 and its components is a stabilizer being linked to the joint member.

7. **Claims 84-89, 92-94, and 97-100, are rejected under 35 U.S.C. 102(e) as being anticipated by Cartier (6,102,854).**

Cartier discloses a surgical system 1 comprising: a retractor 2/3/4 including a drive mechanism 2, two retractor blades 7 being drivable by the drive mechanism 2; and an instrument mount assembly 50 slidably mounted on one of the blades along the rail 40 (Figs. 1A and 2). The instrument mount assembly 50 is capable of receiving and fixing a surgical instrument 60/30 in multiple locked, unlocked, or partially-locked configurations with respect to itself. The instrument mount assembly 50 is also capable of fixing itself in multiple locked, unlocked, or partially-locked configurations with respect to the retractor (Fig. 1). Cartier et al. further disclose a single actuator 51 which is also a quick-release mechanism which can lock and unlock two joints included in the instrument mount assembly 50 (Figs. 3, 5B; column 10 lines 60-67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cartier (6,102,854) in view of Benetti et al. (2001/0044572).**

Cartier et al. disclose the invention substantially as claimed according to claims 101-106. However, Cartier et al. fail to disclose the stabilizer comprising a plurality of interconnecting links articulating with the joint member and the stabilizer.

Benetti et al. show a stabilizer system comprising an instrument mount, a stabilizer where the mount and the stabilizer are connected by a plurality of interconnecting links (Fig. 6). A cable runs through the links and when a tension is applied thereto, the links are fixed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the rod of Cartier, with the flexible system of Benetti to enable the surgeon to place the stabilizer in many more orientations.

10. **Claims 95-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cartier (6,102,854) in view of Hancock (6,331,157 B2).**

Cartier et al. disclose the invention substantially as claimed in claims 84. However, Cartier et al. are silent to the open slots on the retractor blade for receiving and securing sutures therein.

Hancock discloses a retractor having suturing lots 66 on the retractor blade (Fig. 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cartier et al. by including the suturing slots in order to receive and secure sutures therein.

Response to Arguments

11. Applicant's arguments filed on 01/14/2008 have been fully considered. Applicant's arguments regarding the double patenting rejection are not persuasive. The newly amended claims to include "a single actuator" do not overcome the double patenting rejection(s). The claim language/limitation "a single actuator" is considered to be equivalent and/or covered by the claim language "at least an actuator" of the Patent 6,685,632.

Applicant's arguments Hancock lacking "a single actuator locking or unlocking both first and second articulating joints" in the newly amended claim(s) are persuasive but moot in view of new ground(s) of rejections under Looney (5876332).

Applicant's arguments Cartier et al. lacking "a single actuator locking or unlocking both first and second articulating joints" in the newly amended claim(s) are not persuasive. Cartier et al. disclose a single actuator 51 which can both lock the grip member 50 to the stable support/rail 40 and lock an orientation of the surgical instrument 60 (Figs. 3, 5B; column 10 lines 60-67).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened

statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hao D Mai/
Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732